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TRI04546P00161US
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
JOSEPH M. KOENIG, JR.) SANDING BLOCK
Serial No. 10/692,703) Group Art Unit 3727
Filed October 24, 2003) Examiner Maurina T. Rachuba

TRANSMITTAL OF APPELLANT'S BRIEF ON APPEAL

Mail Stop Appeal Briefs-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed herewith are the following:

(1) Brief on Appeal (including an Appendix of Claims) in regard to the above-referenced patent application; and

37 CFR 1.8
CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Briefs-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on December 1, 2008.

Signature: Karen Sanderson

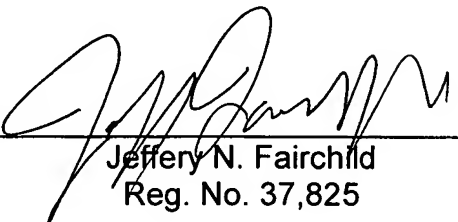
Name: Karen Sanderson

(2) A check in the amount of \$270.00 to cover the fee set forth in 37 CFR §1.17(c).

If any additional fees are required, they should be charged to our Deposit Account No. 23-0785.

Respectfully submitted,

WOOD, PHILLIPS, KATZ,
CLARK & MORTIMER

By 
Jeffery N. Fairchild
Reg. No. 37,825

December 1, 2008

500 West Madison Street
Suite 3800
Chicago, IL 60661-2562
(312) 876-1800



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APPELLANT'S BRIEF ON APPEAL

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This brief is in support of the Notice of Appeal filed September 30, 2008.

REAL PARTY IN INTEREST

The real party in interest is Trim-Tex, Inc., owner by Assignment.

**37 CFR 1.8
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Signature: _____

Karen Sanderson

Name: _____

Karen Sanderson

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RELATED APPEALS AND INTERFERENCES

A Notice of Appeal was filed on January 4, 2006 in the present application together with a Pre-Appeal Brief Request for Review. A Notice of Panel Decision from Pre-Appeal Brief Review was issued on January 30, 2006 maintaining the application under appeal. An Appeal Brief was filed on March 2, 2006 in the present application and prosecution was reopened in view of the Appeal Brief as noted in an Office Action dated April 26, 2007.

STATUS OF CLAIMS

Claims 1-12 are pending in the application and stand finally rejected. The rejection of claims 1-12 are being appealed.

STATUS OF AMENDMENTS

There have been no amendments filed subsequent to final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 is directed towards a sanding block (10) including an abrasive grit bonded to a flexible, compressible, polymeric foam core. (Page 3, lines 17-19; Fig. 1). The sanding block (10) conforms, when viewed macroscopically before the sanding block (10) becomes worn, substantially to a block having two expansive sides (12) and two adjacent sides (14). (Id.) One of the expansive sides (12) is abrasive and has two opposite edges, at each of which one of the adjacent sides (14) adjoins the given one of the expansive sides (12). (Id.) A given one of the opposite edges, when viewed macroscopically before

the sanding block becomes worn, is a sharp edge, and wherein the other one of the opposite edges, when viewed macroscopically before the sanding block becomes worn, is a curved edge. (Page 4, lines 6-9).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-12 are pending in the application. Claims 1, 2, 5 and 9 are finally rejected under 35 U.S.C. §103(a) as being unpatentable over Kingman 2,386,900 in view of Meyer 5,429,545. Claims 3, 4, 6-8 and 10-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kingman in view of Meyer as applied to claim 1, and further in view of Hays 2,553,254. The rejection of claims 1-12 are being appealed.

ARGUMENT

The Rejection Ignores the Express Teachings of Kingman and Proposes a Modification That Is Contrary to These Express Teachings

The “prior art must be considered in its entirety, including disclosures that teach away from the claims”, and “references cannot be combined where references teach away from their combination.” (See MPEP §2145 X.D.) Kingman expressly states that its object is to provide a scouring device having “a substantially rigid body or core” (Kingman, col. 1, lines 8-1) and consistent with this object, repeatedly teaches that its scouring device should have a rigid body or block (see, for example, col. 1, lines 41-46 and the first line of each of claims 1-5). In this regard, the requirement for a “rigid block” in each of the claims cannot be ignored because it is the claims that describe the invention and Kingman expressly requires “a rigid block” in every single claim defining its invention. Despite this

overwhelming showing in Kingman, the present Office Action continues to assert that it would be obvious to replace the rigid block required for the invention of Kingman with a non-rigid body as allegedly taught by Meyer. This specific substitution required by the proposed modification in rejecting the claims is expressly taught away from by Kingman's requirement that it have a substantially rigid body or core. "It is improper to combine references where the references teach away from their combination." (See MPEP §2145 X.D. quoting *In re Grasselli*, 713 F.3d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)). For this reason alone, the proposed modification in the rejection is improper and should be withdrawn.

In response to the above argument, the present Office Action asserts that: "It is the Examiner's position that Kingman therefor teaches the desirability of providing at least part of the tool with a material that is flexible and compressible." (emphasis added) However, this assertion conveniently ignores Kingman's very express teaching that "at least part of the tool", namely its core, be made from a rigid material. In making a rejection, the Examiner is not allowed to simply ignore portions of the prior art that are inconvenient for the arguments asserted by the Examiner, particularly those statements which are in the reference relied on for the rejection.

The current Office Action goes on to assert that "There is no teaching against providing at least part of the tool of a flexible and compressible material." (emphasis added) Again, this assertion ignores the fact that there is an express teaching in Kingman against providing an entire tool of a flexible and compressible material, particularly the core, such as is proposed in the rejection.

The present rejection also asserts that “it would have been obvious to one skilled in the art to substitute one material for the other to achieve the predictable result of a hand tool that conforms to the shape of the workpiece.” (emphasis added) However, this benefit is already expressly achieved by the structure in Kingman. In this regard, Kingman expressly states at column 3, lines 45-54 that “Since the coating 19 of the device is, per se, of resilient character, the same will sufficiently yield under pressure toward the surface undergoing treatment as to assure intimate conforming contact therewith, and so as to further assure that the abrasive material or grit 20 carried thereby will be brought into intimate and firm scraping and scouring engagement with said surface, when the device is rubbed back and forth over the latter.” Kingman’s disclosure that “the material of the tool” was “selected to conform to the shape of the workpiece” could not be any clearer, and the benefit argued in the rejection is thus already expressly achieved by the unmodified structure in Kingman. It cannot be obvious to modify a structure to provide a benefit that is already provided by the structure. In this regard, it should be noted that no rationale is provided in the rejection as to why the proposed modification would provide a superior result with respect to conforming to the shape of the workpiece than what is already expressly achieved by Kingman.

The present Office Action also asserts that “Meyer clearly teaches making a tool with the entire tool being made of a material that is flexible and compressible, to allow the entire tool to conform to the surface being abraded.” However, this assertion ignores that Kingman teaches exactly the opposite of this by requiring a rigid body or block. Kingman

cannot be modified contrary to its express teachings, regardless of what Meyer may or may not teach.

Furthermore, the proposed modification changes the principal operation of Kingman by requiring a substantial reconstruction and redesign of one of Kingman's basic elements, its "substantially rigid body or core". See MPEP §2143.01 VI. stating that "If the proposed modification or combination of the prior art would change the principal of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious" and noting the decision in *In re Ratti*, 270 F.2d 810 (CCPA 1959) wherein the court held that "The suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principal under which the [primary reference] construction was designed to operate." In this case, it cannot fairly be argued that the "substantially rigid body or core" of Kingman is not essential to its scraping and scouring functions, particularly since the use of "a substantially rigid body or core" is expressly required in the stated object of Kingman, repeatedly referenced throughout the disclosure of Kingman, and contained in every single claim of Kingman defining its invention.

Accordingly, for each of these additional reasons, the rejections based on the modification of Kingman with Meyer is improper and should be withdrawn, including the rejection of claims 3, 4, 7 and 8.

**The Rejection Fails to State Any Rationale Whatsoever
for the Further Modification of Kingman with Hays**

The present Office Action fails to state any rationale or cite any evidence whatsoever for its proposed modification of Kingman with Hays. Indeed, no Office Action in this case has provided such a rationale, despite numerous and express requests for such a rationale. Rather, the rejection acknowledges the shortcomings of its combination of Kingman and Meyer with respect to claims 3, 4, 6-8 and 10-12, and then discusses the structure allegedly disclosed by Hays, without any statement whatsoever as to why one skilled in the art would further modify Kingman with the disclosure of Hays. Absent such a rationale, the rejection fails to meet the standards set forth in the MPEP for stating a *prima facie* case of obviousness and accordingly, it is improper and should be withdrawn. For this additional reason, it is believed the rejection of claims 3, 4, 6-8 and 10-12 is improper.

In view of the foregoing, Applicant respectfully requests reconsideration of the finality of the rejection and the rejections of claims 1-12, and allowance of the case.

SUMMARY

The rejections are improper because:

- (a) the primary reference expressly teaches away from the proposed modification in the rejection;
- (b) the proposed modification requires a substantial reconstruction and redesign of the primary reference as well as a change in the basic principal under which the construction was designed to operate;

- (c) the benefit relied on in the rationale for making the proposed modification is already achieved by the primary reference and the rejection makes no assertion as to why one skilled in the art would modify the primary reference to obtain a benefit already realized in the original form of the primary reference; and
- (d) no rationale whatsoever has been provided for the modification proposed in the rejection of over half of the claims.

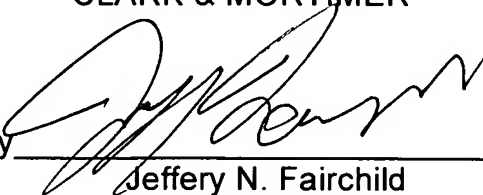
CONCLUSION

In view of the foregoing, Applicants respectfully request withdrawal of the rejection of claims 1-12, and allowance of the case.

Respectfully submitted,

WOOD, PHILLIPS, KATZ,
CLARK & MORTIMER

By



Jeffery N. Fairchild
Reg. No. 37,825

December 1, 2008

500 West Madison Street
Suite 3800
Chicago, IL 60661-2562
(312) 876-1800

APPENDIX OF CLAIMS

1. A sanding block comprising an abrasive grit bonded to a flexible, compressible, polymeric foam core, the sanding block conforming, when viewed macroscopically before the sanding block becomes worn, substantially to a block having two expansive sides and two adjacent sides, wherein a given one of the expansive sides is abrasive, wherein the given one of the expansive sides has two opposite edges, at each of which one of the adjacent sides adjoins the given one of the expansive sides, wherein a given one of the opposite edges, when viewed macroscopically before the sanding block becomes worn, is a sharp edge, and wherein the other one of the opposite edges, when viewed macroscopically before the sanding block becomes worn, is a curved edge.

2. The sanding block of claim 1 wherein, when viewed macroscopically before the sanding block becomes worn, the curved edge defines a radius not less than about $\frac{1}{8}$ inch at any location on said curved edge.

3. The sanding block of claim 1 wherein, when viewed macroscopically before the sanding block becomes worn, the sharp edge defines an acute angle in a range from about 55° to about 70° .

4. The sanding block of claim 2 wherein, when viewed macroscopically before the sanding block becomes worn, the sharp edge defines an acute angle in a range from about 55° to about 70°.

5. The sanding block of claim 1 wherein the adjacent side adjoining the given one of the expansive sides at the sharp edge also is abrasive.

6. The sanding block of claim 2 wherein the adjacent side adjoining the given one of the expansive sides at the sharp edge also is abrasive.

7. The sanding block of claim 3 wherein the adjacent side adjoining the given one of the expansive sides at the sharp edge also is abrasive.

8. The sanding block of claim 4 wherein the adjacent side adjoining the given one of the expansive sides at the sharp edge also is abrasive.

9. The sanding block of claim 5 wherein the other one of the expansive sides and the other one of the adjacent sides also are abrasive.

10. The sanding block of claim 6 wherein the other one of the expansive sides and the other one of the adjacent sides also are abrasive.

11. The sanding block of claim 7 wherein the other one of the expansive sides and the other one of the adjacent sides also are abrasive.

12. The sanding block of claim 8 wherein the other one of the expansive sides and the other one of the adjacent sides also are abrasive.

EVIDENCE APPENDIX

There is no evidence that has been entered by the Examiner and relied upon by Appellant.

RELATED PROCEEDING APPENDIX

There has been no decision by a Court or the Board in any proceeding identified pursuant to (c)(1)(ii) of 37 C.F.R. §41.37.